

REMARKS

In the Office Action mailed December 6, 2005, the Examiner rejected claims 1-17 and allowed claims 18-20 and indicated claims 7 and 10 as allowable if rewritten in independent form. Applicants thank the Examiner for the indication of allowed and allowable subject matter. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 1, 12 and 18. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Objections

The Office Action objected to claim 18 because the word "positioning" was spelled incorrectly. Applicants have amended claim 18 such that the word is now properly spelled.

II. Rejections under 35 USC 112

The Office Action rejected claims 1-17 under 35 USC 112. In particular, the Office Action rejected claims 1 and 12 for the use of the phrase "the member" without proper antecedent basis. Applicants have amended claims 1 and 12 such that proper antecedent basis is now provided.

Applicants note that claim 12 and its dependents were only rejected under 35 USC 112. As such, Applicants assume that claim 12 and its dependents are now allowable since no prior art rejections were asserted against claim 12 and its dependents. Applicants request indication of allowance for claim 12 and its dependents.

III. Rejections under 35 USC 103

The Office Action rejected claims 1-6, 9 and 11 under 35 USC 103 as being obvious over WO 98/36944 (Chang et al.) in view of Anderson et al. (6,376,059). Applicants traverse these rejections on the grounds that the Office Action does not establish a prima facie case of obviousness against claim 1 and does not provide a motivation sufficient to maintain an obviousness rejection against claim 1.

The MPEP 2143.03 reads, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), wrote:

The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the

burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

A. The Office Action does not establish a prima facie case of obviousness against claim 1.

Applicants contend that the Office Action fails to show how the cited references teach or suggest the subject matter of Claim 1 and its dependents. Claim 1 recites the steps of: i) molding a thermoplastic polymeric material to form a first carrier having a cellular structure; ii) applying expandable material upon the first carrier to form the member; and iii) inserting the member within the cavity of the structure. As such, the "member" being inserted within the "cavity of the structure" as recited in claim 1 is a member having a carrier with a cellular structure and expandable material applied thereto. In contrast, Chang et al. discloses, at most, the location of two expandable materials, which are not yet expanded, within a cavity. Chang et al. does not disclose insertion of member that has a cellular carrier and expandable material within a cavity of a structure as recited in claim 1. Moreover, Anderson et al. does not supplement this deficiency of Chang et al. in a manner that would actually suggest insertion of member that has a cellular carrier and expandable material within a cavity of a structure. As such, the Office Action has not established that the subject matter of claim 1 is suggested by the cited prior art references and/or the knowledge generally available to the skilled artisan. Applicant respectfully request that the rejection of claim 1 and its dependents be withdrawn.

B. The Office Action does not provide a motivation sufficient to maintain an obviousness rejection against claim 1.

Applicants additionally contend that the Office Action fails to provide a motivation sufficient to maintain the obviousness rejection of claim 1 and its

dependents. The Office Action, at page 3, suggests, as motivation for the combination of Anderson et al. with Chang et al., that it would have been obvious to substitute the technique, "employed by Anderson et al. into the method of Chang et al. since each technique has been shown to successfully produce cellular material." Applicants contend, however, that this motivation is inadequate to maintain the asserted obviousness rejection since the motivation provides no particular reason, from the prior art or the general knowledge of the skilled artisan, that the process of Anderson et al. would be suitable for producing the member of Chang et al. Moreover, Applicants suggest that the substitution of the technique of Anderson et al. into Chang et al. would at least partially destroy the utility of the member of Chang et al since the expandable materials of Chang et al. are designed to become cellular within a cavity rather than prior to insertion within the cavity. As such, Applicants request that the rejection of claim 1 and its dependents be withdrawn.

Furthermore, Applicant points out that it would likely be improper to present a final rejection of claims 1-6, 9 and 11 on a grounds alternative to that already presented since applicants have not amended those claims in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient

showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

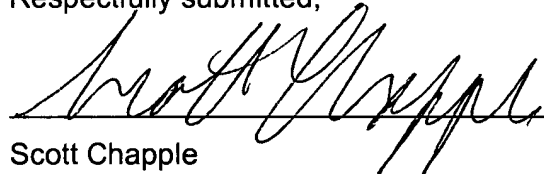
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

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Respectfully submitted,



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